THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte H. DeWAYNE ASHMEAD

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Appeal No. 94-3206
Application 07/823,827[1]

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ON BRIEF

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Before WINTERS, SOFOCLEOUS, and WILLIAM F. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 4, 7 through 13, 15 through 18, and 20, all the claims in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A method for facilitating digestion of carbohydrates into simple sugars in warm-blooded animals by maintaining and enhancing the natural disaccharidase

[1] Application for patent filed January 22, 1992.

enzymatic activity in the mucosal cells of the small intestine which comprises the steps of:

(1) determining the need for improvement in digestibility of carbohydrates in said animal as evidenced by the monitoring of the carbohydrate digestion coefficient of said animal;

(2) providing a composition containing an effective amount of iron and at least one other mineral selected from the group consisting of zinc, copper, manganese and cobalt and mixtures thereof said iron and each of said other minerals being present in the form of an amino acid chelate having a ligand to iron or other mineral mole ratio of at least 1:1, a molecular weight of no more than 1500 daltons and a stability constant of between about 10^6 and 10^{16} as needed, based upon said carbohydrate digestion coefficient determination, to maintain and enhance said enzymatic activity in said animal, and

(3) orally administering an effective amount of said composition to said warm-blooded animal for a period of time sufficient to stimulate the production of natural disaccharidase enzymes and enhance the enzymatic activity thereof in said animal.

The references relied upon by the examiner are:

Ashmead et al. (Ashmead) 4,863,898 Sep. 5, 1989

Buts et al. (Buts), "Alteration of intracellular synthesis of surface membrane glycoproteins in small intestine of iron-deficient rats," American Journal of Physiology, Vol. 251, pp. G736-43 (1986)

Claims 1 through 4, 7 through 13, 15 through 18, and 20 stand rejected 35 U.S.C. § 103 as unpatentable over Ashmead in view of Buts. We reverse.

The claims on appeal are directed to a method which includes administering a composition which contains iron and at least one other specified mineral in the form of an amino acid chelate to an animal. However, this composition is not administered to

any animal. Rather, the composition is administered to an animal in need of improvement in digestibility of carbohydrates. Thus, according to claim 1 on appeal, the claimed method requires determining the need for improvement in digestibility of carbohydrates in an animal by monitoring the carbohydrate digestion coefficient of the animal.

Appellant relies upon this aspect of the claims on appeal in arguing for the patentability of the claims. See, e.g., the paragraph bridging pages 13-14 of the Appeal Brief ("The claimed invention calls for a determination of the need for improved carbohydrate digestibility by monitoring of the digestion coefficient and then formulating a composition . . . as determined by the need to improve carbohydrate digest."). Appellant specifically argues at page 14 of the Appeal Brief that "[t]he prior art is silent as to the need to monitor the digestion coefficient."

The examiner characterizes the claimed method at page 3 of the Examiner's Answer as "a method of increasing disaccharidase activity in warm-blooded animals by administering a composition containing iron in the form of an amino acid chelate." Nowhere in the Examiner's Answer does the examiner recognize that the claimed invention also requires a specific "determining" step. By its terms, 35 U.S.C. § 103 requires that obviousness be determined on the basis of the claimed "subject matter as a whole." Where as here, the examiner's obvious determination has been premised

upon less than the entire claimed subject matter, that obviousness determination is legally incorrect. Accordingly, on this record, we reverse the examiner's rejection under 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

Sherman D. Winters Administrative Patent Judge	)	
Michael Sofocleous Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
William F. Smith Administrative Patent Judge	)	

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